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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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23550 7590 05/04/2009 HOFFMAN WARNICK LLC 75 STATE STREET 14TH FLOOR ALBANY, NY 12207			EXAMINER CAMPBELL, JOSHUA D	
			ART UNIT 2178	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

Office Action Summary

Application No.

09/709,433

Applicant(s)

STEWART ET AL.

Examiner

JOSHUA D. CAMPBELL

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date: 2/4/2009
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 2/3/2009 and IDS filed on 2/4/2009.
2. Claims 12-33 are pending in this case. Claims 12, 17, 20, 24, 28, 29, and 31 are independent claims. Claims 12, 17, 19, 20, 24, 27-29, and 31 have been amended.
3. The rejection of claim 28 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter has been withdrawn due to amendments.

Claim Objections

4. The examiner would like to point out that the claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure (See MPEP § 2111.04). The use of the phrase "wherein" in claims 12, 20, and 31 (specifically claim 12, line 6; claim 20, line 5; and claim 31, lines 6 and 7) does not limit that claims due to the fact that the language suggests but does not require the stated functionality to actually be present, thus any statement in the claims that is preceded by the phrase "wherein" is not considered to provide any limitation to claims.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 12-16, 20-27, and 31-33 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for , does not reasonably provide enablement for generating and transmitting print files and prompting the user without any further user interaction after the request to print. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The specification at no point discusses performing all of these steps with no further user interaction. In fact, the specification actually discusses that a user would have to manually log in to the system between the steps of generation and transmission (page 23, lines 9-14 of applicant's specification). The claims also directly contradict themselves, by stating that prompting the user to preview a bound copy of the print file is performed without further user interaction, however the claim requires that a configuration interface is requested manually by the user and used to obtain configuration information to define what the bound copy of the print file would look like in the preview and only after the configuration information has been entered is the preview generated, thus it is unclear how the user would be prompted to preview something (a bound copy of the print file) that has not yet come into existence.

The examiner has rejected the claims below as if the phrase in question (with no further user interaction) was not included in the claims. The applicant has two courses of action to overcome this rejection:

A) Point out exactly where in the specification it states that all of these steps can be performed with no user interaction after the original print request, at which point if the examiner agrees and withdraws this scope of enablement rejection, the claims would be properly enabled and it is believed that claims 12-16, 20-27, and 31-33 would be allowable once all of the claim objections and 112 second paragraph rejections were overcome.

B) Remove the phrase "with no further user interaction" from the claims in question via an amendment, at which point the rejection found below will address the examiner position on the claims in question.

Regardless of the course of action taken, proper correction is required.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 20-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim limitations of claims 20 and 23-27 use the phrase "means for" or "step for", but they are modified by some structure, material, or acts recited in the claim. It is unclear whether the recited structure, material, or acts are sufficient for performing the

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claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph, because they are modified by some structure, material, or acts recited in the claim.

If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that the phrase “means for” or “step for” is clearly **not** modified by sufficient structure, material, or acts for performing the claimed function.

If applicant does **not** wish to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that it will clearly not be a means (or step) plus function limitation (e.g., deleting the phrase “means for” or “step for”). Proper correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. Claim 28 remains rejected under 35 U.S.C. 102(e) as being anticipated by Tonkin (US Patent Number 6,134,568, filed October 30, 1998).

Regarding dependent claim 28, Tonkin discloses a preview area for displaying a preview of a configured copy of a document wherein the preview is based on a print file and configuration information for the document which includes at least one printing option and defines how to assemble a printed copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of Tonkin). Tonkin discloses a navigation area that enables a user to select a portion of the preview displayed in the preview area, and a estimate area for displaying the price estimate for the configured copy based on the print file and configuration information (column 12, line 23-column 13, line 51 of Tonkin). Tonkin also discloses a configuration area which allows the user to alter the configuration information, which is automatically reflected in the preview of the document (column 7, lines 11-46 of Tonkin).

Claim Rejections - 35 USC § 103

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 17, 19, and 31 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Adamske et al. (US Patent Number 6,625,234, filed on May 11, 1999).

Regarding independent claim 17, Adamske discloses a method in which a user uses software on a client device to generate a print file by requesting to generate it which is identified by a unique identifier (the file name) and uploads it to a server or a print file may be generated on a server based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface (configuration graphical user interface) provides a printing options section that allows a user to provide configuration information including finishing and binding options that define how to assemble the printed copies (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). A plurality of copies are printed and assembled in accordance with the configuration information (column 5, line 64-column 7, line 56 of Adamske).

Regarding dependent claim 19, Adamske discloses a method in which a print drive is installed on the client in order to generate the print file (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a print driver is installed on the client and a print file is generated using the print driver, at which point the print file is uploaded to the server (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which the print driver necessary is automatically selected (column 5, line 64-column 7, line 15 of Adamske). Adamske does not disclose a method in which the print driver is listed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed to have listed

the print driver of Adamske because it would have allowed the user to see the format type the print file would be in.

Regarding independent claim 31, Adamske discloses a method in which a user uses software on a client device to generate a print file and uploads it to a server or a print file may be generated on a server based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a printing options section that allows a user to provide configuration information including finishing and binding options that define how to assemble the printed copies (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). A plurality of copies are printed and assembled in accordance with the configuration information (column 5, line 64-column 7, line 56 of Adamske).

13. Claims 12-16, 18, 20-27, 29, 30, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adamske et al. (US Patent Number 6,625,234, filed on May 11, 1999) in view of Tonkin (US Patent Number 6,134,568, filed October 30, 1998).

Regarding independent claim 12 and dependent claims 32 and 33, Adamske discloses a method in which a user uses software on a client device to generate a print file based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). The user then uploads the print file to the server, this print file (PostScript) being capable of being directly printed by a printer (column 5, line 64-column 7, line 15

of Adamske). Adamske discloses a method in which a user interface (configuration wizard) is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options) (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). Adamske does not directly disclose in this embodiment that a preview is generated by the server and provided to the user based on the print file that was uploaded. However, Adamske discloses an alternate method in which the server generates a preview based on the print file and the configuration information and provides that preview to the user for display at the client device (column 5, line 64-column 7, line 15 of Adamske). It would have been obvious to one of ordinary skill in the art to combine the two methods of Adamske because it would have allowed the client system to do less work in the process.

Additionally, Adamske does not explicitly disclose that the configuration information obtained before the preview is generated contains finishing and binding options which the preview is based on. However, Tonkin discloses that a print preview of a document is generated based on configuration information which includes binding and finishing options for a printed copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of Tonkin). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Adamske with the teachings of Tonkin because it would have allowed a review of what the fully

assembled document would like to help avoid any miscommunications between the author and the assembler.

Regarding dependent claim 13, Adamske discloses a method in which a print drive is installed on the client in order to generate the print file (column 5, line 64-column 7, line 15 of Adamske).

Regarding dependent claim 14, Adamske discloses a method in which a print driver is installed on the client and a print file is generated using the print driver, at which point the print file is uploaded to the server (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which the print driver necessary is automatically selected (column 5, line 64-column 7, line 15 of Adamske). Adamske does not disclose a method in which the print driver is listed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed to have listed the print driver of Adamske because it would have allowed the user to see the format type the print file would be in.

Regarding dependent claim 15, Adamske discloses a method in which a user interface is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options) (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske).

Regarding dependent claim 16, Adamske discloses a method in which styles and printing options for the document are obtained and shown via the preview, which is then provided to the client (column 5, line 64-column 7, line 56 of Adamske).

Regarding dependent claim 18, Adamske discloses a method in which a user uses software on a client device to generate a print file and uploads it to a server or a print file may be generated on a server based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). Adamske also discloses a method in which a user interface is generated that may be web based (on the server) (column 5, line 64-column 7, line 15 of Adamske). The interface provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options) (column 5, line 64-column 7, line 56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). Adamske also discloses a method in which styles and printing options for the document are obtained and shown via the preview, which is then provided to the client (column 7, lines 16-56 of Adamske).

Additionally, Adamske does not explicitly disclose that the configuration information obtained before the preview is generated contains finishing and binding options which the preview is based on. However, Tonkin discloses that a print preview of a document is generated based on configuration information which includes binding and finishing options for a printed copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of Tonkin). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Adamske with the teachings of Tonkin because it would have allowed a review of what the fully

assembled document would like to help avoid any miscommunications between the author and the assembler.

Regarding independent claim 20 and dependent claims 21-23, the claims incorporate substantially similar subject matter as claims 12-15. Thus, the claims are rejected along the same rationale as claims 12-15.

Regarding independent claim 24, Adamske discloses a method in which a user uses software on a client device to generate a print file based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). The user then uploads the print file to the server, this print file (PostScript) being capable of being directly printed by a printer (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a preview section printing options section that allows a user to provide configuration information including finishing and binding options that define how to assemble the printed copies (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). A plurality of copies are printed and assembled in accordance with the configuration information (column 5, line 64-column 7, line 56 of Adamske). T Adamske does not directly disclose in this embodiment that a preview is generated by the server and provided to the user based on the print file that was uploaded. However, Adamske discloses an alternate method in which the server generates a preview based on the print file and the configuration information and provides that preview to the user for display at the client device (column 5, line 64-

column 7, line 15 of Adamske). It would have been obvious to one of ordinary skill in the art to combine the two methods of Adamske because it would have allowed the client system to do less work in the process.

Additionally, Adamske does not explicitly disclose that the configuration information obtained before the preview is generated contains finishing and binding options which the preview is based on. However, Tonkin discloses that a print preview of a document is generated based on configuration information which includes binding and finishing options for a printed copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of Tonkin). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Adamske with the teachings of Tonkin because it would have allowed a review of what the fully assembled document would like to help avoid any miscommunications between the author and the assembler.

Regarding dependent claim 25, Adamske discloses a method in which a user uses software on a client device to generate a print file and uploads it to a server or a print file may be generated on a server based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options) (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). A plurality of copies is printed in accordance with a

plurality of addresses that are obtained from the user (column 5, line 64-column 7, line 15 of Adamske). A coversheet and shipping label (memo) is customized for each address and recipient is printed; at point all parts are delivered to the delivery addresses provided by the client (column 7, lines 16-56 of Adamske).

Regarding dependent claim 26, Adamske discloses a method in which payment information is obtained for the copy and the payment is processed using that information (column 6, line 58-column 7, line 15 of Adamske).

Regarding dependent claim 27, Adamske discloses a method in which the print driver generates the print file and an upload manager communicates the file to the server (column 5, line 64-column 7, line 15 of Adamske).

Regarding independent claim 29, Adamske discloses a method in which a user uses software on a client device to generate a print file and uploads it to a server or a print file may be generated on a server based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options) (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). A plurality of copies is printed in accordance with a plurality of addresses that are obtained from the user (column 5, line 64-column 7, line 15 of Adamske). A coversheet and shipping label (memo) is customized for each address and recipient is printed; at point all parts are delivered to the delivery addresses

(column 7, lines 16-56 of Adamske). Adamske does not disclose that the customized memo is obtained from the client. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed the user to create the custom memo on the client rather than the server because it would have provided the user with the ability to create the memo with the same application as the document itself.

Additionally, Adamske does not explicitly disclose that the configuration information obtained before the preview is generated contains finishing and binding options which the preview is based on. However, Tonkin discloses that a print preview of a document is generated based on configuration information which includes binding and finishing options for a printed copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of Tonkin). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Adamske with the teachings of Tonkin because it would have allowed a review of what the fully assembled document would like to help avoid any miscommunications between the author and the assembler.

Regarding dependent claim 30, Adamske discloses a method in which the document may be generated on the client and obtained from the client (column 5, line 64-column 7, line 15 of Adamske).

Response to Arguments

14. Applicant's arguments with respect to claims 12-33 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA D. CAMPBELL whose telephone number is (571)272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joshua D Campbell/
Primary Examiner, Art Unit 2178
April 22, 2009